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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/923,306	08/07/2001	Wayne B. Sherman		9984

7590

02 07 2003

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EXAMINER

HAAS, WENDY C

ART UNIT	PAPER NUMBER
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1661

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DATE MAILED: 02/07/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/923,306

Applicant(s)

SHERMAN, WAYNE B.

Examiner

Wendy C Haas

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 07 August 2001.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 07 August 2001 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s) _____
- 2) ☒ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ 6) ☒ Other: See Continuation Sheet.

Continuation of Attachment(s) 6). Other: Rule 1.105 Requirement for Information.

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DETAILED ACTION

Drawings

The drawings are objected to under 37 CFR 1.165(a) as the paper on which the photographic illustration is printed is too small. New drawings are required. Please see attached Form PTO-948 for instructions on drawing sizes and margins, and the instructions later in this Office action for drawing contents and how to submit drawings to the Office.

35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the statutory basis for a rejection that may be made at a later date in response to this Examiner's Requirement for Information:

A person shall be entitled to a patent unless --

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

The claimed *Prunus persica* variety 'SUNBEST' is described in HortScience 37(2) p. 258. This document was published in April of 2002, and indicates that the instant plant was introduced in the year 2000. If 'SUNBEST' was publicly available or on sale in the United States more than one year prior to the filing date of the instant application, it does not qualify for plant patent protection.

While the publication cited above discloses the claimed plant variety, a question remains as to what meaning is intended by the word "introduced" and the actual date of introduction.

The ability of the Office to determine whether the claimed plant was publicly available is limited. Search of electronic databases, the internet and the Office's collection of retail catalogs has not revealed any other evidence that the claimed plant was on sale anywhere in the world more than one year prior to the filing date of the instant application. However, the Office's collection of retail catalogs is not comprehensive. Furthermore, the claimed plant may have been sold at the wholesale level, sold under a different name, or even distributed to interested parties

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free of charge. Since the inventor and/or assignee of the instant application is/are in a better position to know when, if ever, the claimed plant was made publicly available, the Examiner is requiring this information in a Requirement for Information Under 37 CFR 1.105.

Objection to the Disclosure

37 CFR 1.163

The following is a quotation of section (a) of 37 CFR 1.163:

(a) The specification must contain as full and complete a disclosure as possible of the plant and the characteristics thereof that distinguish the same over related known varieties, and its antecedents, and must particularly point out where and in what manner the variety of plant has been asexually reproduced. In the case of a newly found plant, the specification must particularly point out the location and character of the area where the plant was discovered.

35 USC § 112

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

As specific to United States Plant Patent applications, the specifics of 37 CFR 1.164 (reproduced below) are controlling:

The claim shall be in formal terms to the new and distinct variety of the specified plant as described and illustrated, and may also recite the principal distinguishing characteristics. More than one claim is not permitted.

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In plant applications filed under 35 U.S.C. 161, the requirements of 35 U.S.C. are limited. The following is a quotation of 35 U.S.C. 162:

No plant patent shall be declared invalid for noncompliance with section 112 of this title if the description is as complete as is reasonably possible. The claim in the specification shall be in formal terms to the plant shown and described.

The disclosure is objected to under 37 CFR 1.163 (a) and under 35 U.S.C. 112, first paragraph, because the specification presents less than a full, clear and complete botanical description of the plant and the characteristics which define same per se and which distinguish the plant from related known cultivars and antecedents.

More specifically:

A. Page 1, after line 1, applicant should add the following recitation ***under a separate heading, as shown*** in order to comply with new rule 1.160(c)(4):

--

BOTANICAL CLASSIFICATION

Prunus persica. --

B. Applicant should provide a photographic illustration of the fruit flesh and stone of the instant cultivar, as the illustration provided must show all the distinctive features of the plant capable of representation. Additional information is needed.

C. Applicant must provide detailed information regarding the bloom of the instant plant. See Columns 4 and 5 of United State Plant Patent No. 9,128 for a sample of the information needed.

D. Applicant should describe the kernel portion of the stone: size, shape and color.

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The above listing may not be complete. Applicant should carefully compare the claimed plant with the botanical descriptions set forth in the specification to ensure completeness and accuracy and to distinguish the plant within this expanding market class. Any further botanical information should be imported into the specification, as should any additional or corrected information relative to same.

Claim Rejection

35 U.S.C. § 112, 1st and 2nd Paragraphs

Claim 1 is rejected under 35 U.S.C. 112, first and second paragraphs as not being supported by a clear and complete botanical description of the plant for reasons set forth in the Objection to the Disclosure Section above, and under 35 U.S.C. 112 first paragraph for the reasons advanced in the objection to the drawing.

References Cited

The references cited on the attached PTO-892 are made of record to show the state of the art, the reference from HortScience is believed to disclose the claimed plant.

Comments

E. An examination of this application reveals that applicant is unfamiliar with patent prosecuting procedure. While an inventor may prosecute the application, lack of skill in this field usually acts as a liability in affording the maximum protection for the invention disclosed. Applicant is advised to secure the services of a registered patent attorney or agent to prosecute the application, since the value of a patent is largely dependent upon skillful preparation and prosecution. The Office cannot aid in selecting an attorney or agent.

Applicant is advised of the availability of the publication "Attorneys and Agents Registered to Practice Before the U.S. Patent and Trademark Office." This publication is for sale by the Superintendent of Documents, U.S. Government Printing Office, Washington, D.C 20402.

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F. It is called to applicant's attention that if a communication is deposited with the U.S. Postal Service and mailed to the Office by First Class Mail before the reply time has expired, applicant may submit the reply with a "Certificate of Mailing" which merely asserts that the reply is being mailed on a given date. So mailed, before the period for reply has expired, the reply may be considered timely.

A suggested format for a certificate follows:

I hereby certify that this correspondence is being deposited with the United States Postal Service as First Class Mail in an envelope addressed to:

Assistant Commissioner for Patents

Washington, D.C. 20231

on _____ (date).

Typed or printed name of person signing this certificate

Signature

Date

G. Applicant is advised of the new procedures for amending the specification and claim under 37 CFR 1.121. The new procedures are optional until February 28, 2001 and mandatory beginning March 1, 2001. Information on the new procedures, as well as other changes to the rules of practice, is available on the Internet at:

<http://www.uspto.gov/web/offices/dcom/olia/pbg/index.html>.

H. Applicants are advised of the changes to 37 CFR 1.84 which took effect November 29, 2000. In particular, 37 CFR 1.84(e) now states, in part:

Photographs must be developed on paper meeting the sheet size requirements of paragraph (f) of this section and the margin requirements of paragraph (g) of this section.

The USPTO no longer accepts photographs mounted on bristol board, paper or other material. Further information on the new rules is available on the USPTO web site at www.uspto.gov.

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I. Mail sent to the United States Patent and Trademark Office is routinely irradiated due to heightened security concerns. Photographs do not survive this irradiation process. As such, photographs should be:

(1) Mailed to:

P.O. BOX 2327

Arlington, VA 22202 or

(2) Hand-delivered or sent via UPS or Federal Express to:

Wendy C. Haas / Art Unit 1661

Technology Center 1600

Reception Area, 7th Floor

Crystal Mall One

1911 South Clark Street

Arlington, VA 22202

J. This Office action has an attached requirement for information under 37 CFR 1.105. A complete reply to this Office action must include a complete response to the attached requirement for information. The time period for reply to the attached requirement coincides with the time period for reply to this Office action.

Future Correspondence

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Wendy C. Haas whose telephone number is (703) 308-8898. The Examiner is normally available Monday through Friday from 9 a.m. to 5:30 p.m.

If attempts to reach the Examiner by telephone are unsuccessful, the Examiner's supervisor, Bruce Campell, can be reached on (703) 308-4205. The fax number for the group is (703) 305-3041 or (703) 308-4242. The Examiner's fax number is (703) 746-3166.

Any inquiry of a general nature or relating to the status of this application should be directed to the Matrix Customer Service Center whose telephone number is (703) 308-0196.

W. C. Haas

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REQUIREMENT FOR INFORMATION UNDER 37 CFR 1.105

Applicants and/or the assignee(s) of this application are required under 37 CFR 1.105 to provide the following information that the examiner has determined is reasonably necessary to the examination of this application.

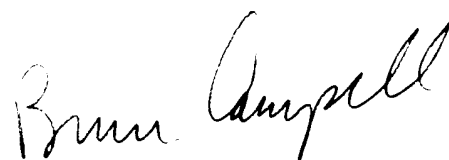
The information is required to determine when, if ever, the claimed plant variety, 'SUNBEST', was publicly available prior to the filing date of the instant application.

In response to this requirement please provide any information available regarding the sale or other public distribution of the claimed plant variety anywhere in the world, including the date(s) of any sale or other public distribution.

The fee and certification requirements of 37 CFR 1.97 are waived for those documents submitted in reply to this requirement. This waiver extends only to those documents within the scope of this requirement under 37 CFR 1.105 that are included in the applicants' first complete communication responding to this requirement. Any supplemental replies subsequent to the first communication responding to this requirement and any information disclosures beyond the scope of this requirement under 37 CFR 1.105 are subject to the fee and certification requirements of 37 CFR 1.97.

The applicants are reminded that the reply to this requirement must be made with candor and good faith under 37 CFR 1.56. Where the applicants do not have or cannot readily obtain an item of required information, a statement that the item is unknown or cannot be readily obtained will be accepted as a complete response to the requirement for that item.

This requirement is an attachment of the enclosed Office action. A complete reply to the enclosed Office action must include a complete response to this requirement. The time period for reply to this requirement coincides with the time period for reply to the enclosed Office action, which is 3 months.



**BRUCE R. CAMPBELL, PH.D.
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 1600**